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### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 14, 2005 ("Office Action"). Claims 1-19 and 21 currently stand rejected.

#### Section 103(a) Rejections

The Office Action rejected Claims 1-19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0069272, listing Kim, et al. as inventors ("*Kim*") in view of U.S. Patent No. 6,782,420 issued to Barrett et al., ("*Barrett*"). Applicants respectfully traverse these rejections for the reasons stated below.

Independent Claim 1 is allowable because the proposed combination of *Kim* and *Barrett* fails to disclose, teach or suggest "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." The Office Action acknowledges that *Kim* does not disclose this limitation. See Office Action, Page 3. Rather, the Office Action argues that *Barrett* discloses this limitation, indicating that "Barrett et al. teaches a network management (see Abstract) method in which a result set is automatically collected from network elements (see col. 12, lines 17-20). This information is collected by a management server (see col. 11, line 36)." But, this is incorrect for two reasons. The first reason is that the claim limitation recites "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set" not "a result set . . . automatically collected from network elements." It can not be disputed that these two things are different. Accordingly, even if the Office Action's above assertion were correct, such an assertion would not disclose the above limitation.

The second reason is that the cited portions of of *Barrett* (Col. 12, lines 17-20 and Col. 11, line 36) do not disclose the above limitation. The entirety of both cited portions, which are within *Barrett*'s claim section, are below:

(1) Column 11, line 36 states:

"with at least one managed object in communication"

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(2) Column 12, line 17-20 states:

"12. The telecommunications network of claim 1 in which the element management server includes means for automatically polling the plurality of network elements for status information associated with the parent command object."

Clearly, neither of these limitations disclose "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." Rather, they generally describe polling network elements for information. Further details of this polling is provided at Column 5, lines 6-16 of *Barrett*, clarifying that *Barrett* does not disclose the above limitation. Accordingly, for at least these reasons, Applicants submit that Independent Claim 1 and its dependents, Claims 2-7, are allowable. Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

Independent Claim 1 is additionally allowable because the proposed combination of *Kim* and *Barrett* fails to disclose, teach or suggest "automatically applying a specified set of rules to produce a result set based on the service option selection and the capacity information" and "automatically determining configuration parameters for the one or more network elements based on the result set." With regards to these limitations, the Office Action merely points to paragraphs [0030], [0034], and [0035] of *Kim*. But, this is incorrect. Paragraphs [0030], [0034], and [0035] of *Kim* describe a process of updating a server configuration. As described in these paragraphs, when a user modifies a configuration parameter, an intranet server 30 communicates the modification to a server manager 32. The server manager 32 then updates one or more tables that include the parameter. Then, the server manager 32 communicates commands to one or more servers 22, 24, and 26 indicating that the one or more tables have been modified. Clearly, such a process does not disclose the above limitation. Specifically the process described by Paragraphs [0030], [0034], and [0035] of *Kim* mention nothing about automatically applying a specified set of rules to produce a result set. Further, Paragraphs [0030], [0034], and [0035] mention nothing about automatically determining configuration parameters for the one or more network elements based on the result set. Accordingly, for at least these additional reasons, Applicants submit that Independent Claim 1 and its dependents, Claims 2-7, are allowable.

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Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

Notwithstanding the above reasons for allowance, many of the dependent claims are also allowable because the combined references fails to teach or suggest the additional limitation or limitations recited by respective dependent claims. An example is described below.

Claim 2 is allowable because the combined references fail to disclose, teach, or suggest "receiving provisioning information based on the result set." With regards to this limitation, the Office Action merely points to paragraphs [0026] and [0030], reciting the terms "command" and "resources available to a particular user." However, this is incorrect. With regards to these terms, *Kim* indicates the following:

A client-server network is a dominant model for communicating between two computers. Using this relationship, a client computer (the "client") issues one or more commands to a server computer (the "server"). The server fulfills client commands by accessing available network resources and returning information to the client pursuant to client commands.

(Paragraph [0026] of *Kim*)

In order for the web hosting provider to provide services for both of these clients, application programs which manage the network resources hosted by the servers must be properly configured. The program configuration process generally involves defining a set of parameters which control, at least in part, the application program's response to browser requests and which also define, at least in part, the server resources available to a particular user.

(Paragraph [0030] of *Kim*.) Clearly, neither of the above recitations disclose "receiving provisioning information based on the result set." For at least this additional reason, Applicants submit that Claim 2 is allowable as are its dependents, Claims 3-4. Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

Applicants additionally challenge the Office Action's alleged motivation to combine and modify features from the proposed references. The entirety of this alleged motivation is a follows:

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At the time of the invention, one of ordinary skill in the art would have been motivated to combined the cited disclosure in order to obtain a method for "remote management of network elements" and "to communicate management information concerning the network elements", as taught by Barret et al.

(Office Action, Page 3.) This conclusory reasoning falls short of the required evidence of a motivation to combine and/or modify prior art references. *See Ex Part O'Donnell*, Appeal No. 2004-0421 (The Board found that the Examiner's reason, "it would have been within the scope of one of ordinary skill in the art to combine the teachings of [the references] to achieve further corrosion resistance," an inadequate reason as to why there is a motivation to combine the references.). Undeniably, a substantial modification of the references would need to be undertaken to arrive at the claimed invention. The above reasoning simply does not provide enough impetus to arrive at the claimed invention.

To this end, a reminder is given that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g., In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt."). Further, "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). "[An] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Furthermore, simple hindsight speculation that "it would have been obvious" to make the proposed combination is insufficient under M.P.E.P.<sup>1</sup> guidelines and governing Federal Circuit case law.<sup>2</sup> Moreover, such statements and assumptions are inadequate to support a finding of

<sup>1</sup> *See, e.g., M.P.E.P.* §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>2</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the*

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motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority."<sup>3</sup>

Should a rejection based on any of the above asserted rejections be maintained, Applicants respectfully request appropriate evidentiary support. Additionally, if the Examiner is relying upon "common knowledge" or "well known" principles to establish the rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an "Official Notice" or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

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*teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. 175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).  
<sup>3</sup> See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

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**CONCLUSIONS**

For the foregoing reasons and for apparent reasons, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corp.

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